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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,280	12/31/2003	Koichiro Kishima	SON-2006/CON	6607

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,280	Applicant(s) KISHIMA ET AL.	
	Examiner Aristotelis M. Psitos	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-54 is/are rejected.
- 7) ☒ Claim(s) 40-54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

The IDS of 11/31/03 has been made of record.

Claim Objections

Claims 40-54 are duplicative of claims 24-39. Cancellation of one set of these claims is respectfully required.

Claim 39 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 39 attempts to define a method "for use" limitation with respect to its parent claim – a product. Such is not proper. Similar problem exists with claim 54.

Claims 8 and 15 are drawn to method of manufacturing and do not further limit the product.

In the following analysis, claims 24-54 are discussed together.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 2-4, 16, 17, 24, 27-29, 31 and 34 are rejected under the judicially created doctrine of double patenting over claims 2-5 of U. S. Patent No. 6,683,846 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Similar analysis with respect to duplicate claims 40, 43-45, 51.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The following analysis is made:

Claim 2:

6683846/Claim 1

An information recording disc including:
a signal recording layer for use in
an information recording/reproducing
apparatus having a light source for
emitting a light flux and a focusing element for
focusing the light flux to be applied to the signal
recording layer: and

Claim 2, line 1

claim 2 lines 2-6

a first dielectric layer between said signal
recording layer and said focusing element,

claim 2, lines 6-7

wherein the distance between the focusing element
and a surface portion facing to the focusing
element is not greater than a wavelength of the light
flux,

claim 2 lines 7-10

wherein the surface portion facing to the focusing
element is coated with an anti-reflection coating film,

claim 2, lines 11-12

wherein a first dielectric film is on the signal recording layer, and
the anti-reflection coating layer is on the first dielectric film, so as to
prevent reflection of the light flux incident into the first dielectric film.

claim 2 lines 13-17

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Claim 24

Claim 3/2

An information recording disc comprising:

claim 2, lines 1-5

a signal recording layer, a focusing element

focusing a light flux onto said signal recording layer;

a first dielectric layer, said first dielectric layer

being between said signal recording layer and

said focusing element;

a substrate;

claim 3 line 3

a reflection film, said reflection film being between

claim 3, lines 4-5

said signal recording layer and said substrate;

a second dielectric layer, said second dielectric layer being

claim 3, lines 6-8

between said signal recording layer and said reflection film;

an anti-reflection coating film, said anti-reflection coating film reducing

claim 2, lines 15-17

reflection of said light flux incident into said first dielectric layer,

said anti-reflection coating film including;

claim 2, lines 21-22

a third dielectric film between said signal recording layer

and said focusing element;

a fourth dielectric film between said third

claim 2, lines 23-24

dielectric film and said focusing element;

a fifth dielectric film between said fourth dielectric film

claim 2, lines 26-27

and said focusing element.

With respect to claim 3, this is found in allowed claim 2.

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With respect to claim 4, this is already present in claim 2.

With respect to claim 16, already in allowed claim 3.

With respect to the limitations of claim 27, see allowed claim 4.

With respect to claims 17 & 28 – already included in allowed claim 2.

With respect to claim 29, see allowed claim 5.

With respect to claim 31, already present.

With respect to claim 34, already in allowed claim 3.

Duplicate claims 40,43,44,45 and 47 are met as well

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. Claims 2-4,24, 9-12,14,18,19,26,30,31,34 and 39 are rejected under the judicially created doctrine of double patenting over claims 1,3,6,8,9, 14,21,22 of U. S. Patent No. 6552968 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Similar analysis with respect to duplicate claims 40,43-45,51.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 2:

An information recording disc including:
a signal recording layer for use in
an information recording/reproducing
apparatus having a light source for
emitting a light flux and a focusing element for
focusing the light flux to be applied to the signal

Claim 1 of 6552968

disc claimed/for use limitations no
distinction

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recording layer: and

a first dielectric layer between said signal
recording layer and said focusing element,

first protective layer - see
claim 3.

wherein the distance between the focusing element
and a surface portion facing to the focusing
element is not greater than a wavelength of the light
flux,

inherent in near field systems

wherein the surface portion facing to the focusing
element is coated with an anti-reflection coating film,

claim 1 lines 6-11

wherein a first dielectric film is on the signal recording layer, and
the anti-reflection coating layer is on the first dielectric film, so as to
prevent reflection of the light flux incident into the first dielectric film.

With respect to claim 3 – see allowed claims 3/6.

With respect to claim 4 – already in allowed claim 1.

Claim 24

An information recording disc comprising:
a signal recording layer, a focusing element
focusing a light flux onto said signal recording layer;
a first dielectric layer, said first dielectric layer
being between said signal recording layer and
said focusing element;
a substrate;
a reflection film, said reflection film being between

Claim 8/1

claim 1, line 1
for use, no distinction

claim 1 line 3

claim 8, lines 1-3

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said signal recording layer and said substrate;

a second dielectric layer, said second dielectric layer being claim 9, lines 1-3
between said signal recording layer and said reflection film;

an anti-reflection coating film, said anti-reflection coating film reducing claim 1, lines 6-11
reflection of said light flux incident into said first dielectric layer,

said anti-reflection coating film including; claim 6, lines 1-3.

a third dielectric film between said signal recording layer
and said focusing element;

With respect to claim 34, such is already present in the above claims.

Claim 9

An information recording/reproducing
apparatus comprising:

a rotation mechanism for holding and
rotating an information recording disc;

a substrate;

a reflection film,

said reflection film being between said signal
recording layer and said substrate:

a second dielectric layer, said second

Claim 14

claim 1

obvious/inherent

claim 14, lines 8-15

claim 21

claim 22

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dielectric layer being between

said signal recording layer and said reflection film;

a light source; and

claim 14, lines 3-7

a focusing element for focusing a light flux

emitted from the light source

so as to be applied to a signal recording layer

of the information recording disc;

wherein the information recording disc is used in

inherent

such a manner that a distance between the focusing

element and the surface portion facing to this

focusing element is not greater than a wavelength of

the light flux, and the information recording disc includes

an anti-reflection coating film on the surface

portion facing to the focusing element,

the information recording disc includes a first

present.

dielectric film on the signal recording layer, and

the anti-reflection coating layer of the information

recording disc is on the first dielectric film,

so as to prevent reflection of the light flux incident

into the first dielectric film.

With respect to claim 10, see allowed claim 19.

With respect to claim 11, already present in above claims.

With respect to claim 12, already present in the above claims.

With respect to claim 14, see claim 18.

With respect to claim 18, already present.

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With respect to claim 19, already present in the above claims.

With respect to claim 26,30, 31 and 39 these are present in the above claims

Duplicate claim 54 is met as well.

3. Claims 5-7,25,26,30, 35,36-38 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph one, further considered with the acknowledged prior art/Mori et al.

With respect to the limitations of claim 5, such is considered present in the acknowledge prior art, the 2nd dielectric film/ or Mori et al.

With respect to claims 6,7,25,26,30, 35 and 36 such is also considered present/taught by either the acknowledged prior art/Mori et al.

With respect to the limitations of claims 37-38, this is considered taught by the acknowledged prior art. Alternatively, sils are well known in this environment.

With respect to claim 25, the air gap limitation is considered present in the above combined teachings, i.e., an air gap is present in near field systems.

Duplicate claims 41 and 46 are met as well.

It would have been obvious to modify the base system as relied upon above in paragraph 1 and further with the acknowledged materials taught by either the prior art or Mori et al. Motivation is to use existing recognized materials in this environment and hence save valuable resources such as time in (re)testing materials for their acknowledged properties.

4. Claims 32,33 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph one, further considered with Official notice.

The recording materials defined in these claims is considered old and well known and Official notice is taken thereof. Duplicate claims 48 and 49 are met as well.

It would have been obvious to modify the base system as stated above in paragraph 1 with the well known recording materials, motivation is to use existing materials for their properties.

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5. Claims 20, 21, 22, 23, 28, 29, 35 and 36 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph two, further considered with US 6683846.

The materials defined are taught in the above noted patent to 6683846. Use of such is considered obvious to one of ordinary skill in the art for recognized properties. Alternatively, the acknowledged prior art/Mori et al also teach such materials in this environment.

Duplicate claims 43-44, 50 and 51 are included herewith for the same reasoning.

6. Claims 32, 33 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph two, further considered with Official notice.

The recording materials defined in these claims is considered old and well known and Official notice is taken thereof. Duplicate claims 48 & 49 are included herewith.

It would have been obvious to modify the base system as stated above in paragraph 2 with the well known recording materials, motivation is to use existing materials for their properties.

7. Claims 6, 7, 13, are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph two, further considered with itself.

With respect to these limitations as noted in the above patent ('968) the particular thickness of not less than 100 nm is found in claim 18, hence the limitations of claims 6 and 13 are considered obvious thereover, while claim 7 is considered met by the above claim.

Duplicate claim 42 is included herein.

8. Claims 8 & 15 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraphs one and two respectively, further considered with Official notice.

With respect to these limitations, the method recited—that of burnishing is considered a well known manufacturing technique in this environment, and Official notice is taken thereof.

It would have been obvious to modify the base system as relied upon in paragraphs 1 and 2 and use a well known manufacturing step in order to manufacture/create the disc.

Claims 37 & 38 are rejected under the judicially created doctrine of double patenting over the claims as analyzed above in paragraph two, further considered with the acknowledge prior art description of near field systems which use sil elements.

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It would have been obvious to modify the base system as stated in paragraph two above with the sil element(s), motivation is to use sil(s) for their intended uses in near field systems.

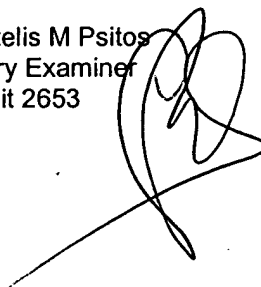
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
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A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the left.

AMP